



No. CITI0122-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Joseph C. Kawan

Group Art Unit: 2164

Serial No.: 09/238,995

Examiner: AKERS, Geoffrey R.

Filed: January 28, 1999

For: **METHOD AND SYSTEM OF CONTACTLESS INTERFACING FOR SMART
CARD BANKING**

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED

DEC 16 2004

GROUP 3600

Sir:

Responsive to the nonfinal Office Action mailed February 21, 2002, Applicant respectfully requests reconsideration in view of the following remarks. A petition and applicable fee to respond within the first extended month is concurrently filed herewith.

REMARKS

Applicant appreciates the attention accorded to the present application. Claims 1-5, 8, 10-17, 22, 27, 33, 39, 42-50, 55-58, 63-66, 69-74, and 79-81 are pending.

The Rejection of Claims Under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 8, 10, 15-17, 22, 27, 33, 39, 42-50, 55-58, 63, 69, 71, 73, 74, and 79-81 under 35 U.S.C. 103(a) as being unpatentable over Fox (USP 5,943,624) ("Fox")

in view of Claus (USP 5,461,217) ("Claus") in view of Jachimowicz (USP 5,789,733) ("Jachimowicz") and further in view of Saitoh (USP 5,929,414) ("Saitoh").

Applicant respectfully traverses the Examiner's rejection for at least the following reasons. For independent claims 1 and 63, the Examiner asserts that Fox shows a physical contact bi-directional communication interface between a smart card and a hand-held computing device for accessing a smart card application on a micro computer of the smart card. *Office Action*, pp. 3 and 10. Applicant respectfully traverses this assertion. Quite to the contrary, a smart card is not even used in Fox. Fox teaches away from using a smart card, and instead teaches incorporating only the electronics found in smart cards for permanent fixture within a cell phone. Col. 1, lines 46-49. Fox explains that the cost of making smart cards and their small size are reasons why smart cards are not a part of his system. *See* Col. 1, lines 40-45 ("[H]ermetically seal[ing] the electronics within the plastic card in order to protect the electronic parts ... substantially increases the cost of the card ... [S]mall plastic smartcards are easy to misplace, lose, or steal ..."). Further, there is not even a way to insert or otherwise physically interface a smart card with Fox's cell phone. *See* Abstract and Fig. 1.

Consistently throughout the reference, Fox teaches away from having a physical contact bi-directional communication interface between "a smart card" and a hand-held computing device. For example, Fox states, "[S]ystems requiring the smartcard to come into contact with the external system suffer from the disadvantages that the smartcard must be physically inserted into the external reader." (Col. 1, lines 22-26). Fox further states, "Additionally, it would be desirable to provide a smartcard that does not require contact with an external reader in order to

perform a transaction.” (Col. 1, lines 50-52). Accordingly, Fox is devoid of any showing of a physical interface between a smart card and a hand-held computing device.

Additionally, the Examiner relies on Jachimowicz, Saitoh, and Claus as modifying references to address other limitations in the claims. However, to combine Fox with these references (all teaching the use of smart “cards”) would destroy Fox and vice versa. Applicant respectfully submits that the Examiner is allowing hindsight from Applicant’s own disclosure to selectively ignore certain prior art teachings.

Notwithstanding the contrary teachings, Jachimowicz, for example, does not even show the limitations it supposedly makes obvious. Some of the claimed limitations include allowing the user to enter identification/transaction information on a handheld computing device and to initiate a contactless interface via the handheld computing device between the smart card application and the self service terminal. See Office Action, pp. 3 and 10.

Instead, Jachimowicz discloses a smart card having contained therein an optical sensor and a light source for the transmission of information. Col. 2, lines 45-53. Fig. 2 of Jachimowicz shows a cross-section of the card with the optical communication components contained within the card itself. Jachimowicz does not show nor suggest contactless communication via a handheld computing device or entering information on the computing device. Nor could Jachimowicz be combined with the cell phone of Fox because the cell phone is not capable of receiving a smart card.

For at least these reasons, and particularly because they pertain to independent claims 1 and 63, Applicant respectfully submits that only through hindsight does the Examiner attempt to

justify the selective combination of the references in an effort to render the invention obvious. It is only the Applicant's disclosure that sets forth the features as claimed.

Additionally, the Examiner rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Fox in view of Claus in view of Saitoh and further in view of Jachimowicz. Because this claim depends from an independent claim, the arguments presented above are equally applicable here.

Also, the Examiner rejected claim 13 under 35 U.S.C. 103(a) as being unpatentable over Fox in view of Claus in view of Jachimowicz and further in view of Pitroda (USP 5,590,038) ("Pitroda"). Because this claim depends from an independent claim, the arguments presented above are equally applicable here.

The Examiner also rejected claim 66 under 35 U.S.C. 103(a) as being unpatentable over Fox in view of Claus and further in view of Saitoh. Because this claim depends from an independent claim, the arguments presented above are equally applicable here.

The Examiner also rejected claims 2-4, 11, 12, 14, 64, 65, and 66 under 35 U.S.C. 103(a) as being unpatentable over Fox in view of Claus and further in view of Jachimowicz. Similarly, because these claims depend from the independent claims, the arguments presented above are equally applicable.

Finally, the Examiner rejected claims 19, 24, 29, 70, and 72 under 35 U.S.C. 103(a) as being unpatentable over Fox in view of Claus and further in view of Pitroda. Applicant notes that claims 19, 24, and 29 had been cancelled. Because the remaining claims depend from an independent claim, the arguments presented above are equally applicable.

CONCLUSION

In light of the foregoing remarks, Applicant respectfully submits that the claims of the present application are in condition for allowance. Should the Examiner determine that any further action is necessary to place this application in better condition, the Examiner is encouraged to telephone Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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6/21/02

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